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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/081,819	02/22/2002	Edward O. Clapper	ITL.0694US (P13225)	3076
21906	7590	04/06/2006	EXAMINER	
TROP PRUNER & HU, PC 8554 KATY FREEWAY SUITE 100 HOUSTON, TX 77024			ANWAH, OLISA	
			ART UNIT	PAPER NUMBER
			2614	

DATE MAILED: 04/06/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

<b>Office Action Summary</b>	<b>Application No.</b> 10/081,819	<b>Applicant(s)</b> CLAPPER, EDWARD O.	
	<b>Examiner</b> Olisa Anwah	<b>Art Unit</b> 2614	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

#### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

#### Status

- 1) ☒ Responsive to communication(s) filed on 09 January 2006.
- 2a) ☐ This action is FINAL. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

#### Disposition of Claims

- 4) ☒ Claim(s) 1-54 is/are pending in the application.
- 4a) Of the above claim(s) 1-8, 15-22, 24 and 31-37 is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 9-14, 23, 25-30 and 38-54 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

#### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

#### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

#### Attachment(s)

- |  |   |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)  | 4) <input type="checkbox"/> Interview Summary (PTO-413)<br>Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)                                   | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152)             |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)<br>Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____  |

**DETAILED ACTION**

***Claim Rejections - 35 USC § 102***

1. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless -

(e) the invention was described in-

(1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effect under this subsection of a national application published under section 122(b) only if the international application designating the United States was published under Article 21(2)(a) of such treaty in the English language; or

(2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that a patent shall not be deemed filed in the United States for the purposes of this subsection based on the filing of an international application filed under the treaty defined in section 351(a).

2. Claims 23, 25-28, 44-47, 49 and 54 are rejected under 35 U.S.C. § 102(e) as being anticipated by DeFazio et al, U.S. Patent No. 5,940,484 (hereinafter DeFazio).

Regarding claim 23, DeFazio discloses a method comprising:

receiving in a first system (see units 4a and 5 from Figure

1) a search query for information associated with a second party (see unit 1 from Figure 1) during a telephone call, the first system comprising a portable device (see unit 4a from Figure 1) separate from a telephone (see unit 4 from Figure 1) and a personal-use computer (see unit 6 from Figure 1) and connectable

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to at least one of a telephone line or the computer (see Figure 1);

obtaining the information from the first system if the information is present in the first system;

searching at least the personal-use computer for the information if the information is not present in the first system; and

providing the information to the first system from the personal-use computer to display the information on the first system during the telephone call (see Figures 3 and 4).

Regarding claim 25, see Figures 3 and 4.

Regarding claim 26, see Figures 3 and 4.

Regarding claim 27, see Figures 3 and 4.

Regarding claim 28, see Figures 3 and 4.

Regarding claim 44, see Figure 1.

Regarding claim 45, see Figure 1.

Regarding claim 46, see Figure 1.

Regarding claim 47, see Figure 1.

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Regarding claim 49, Defazio discloses a system comprising:

a processor (see unit F from Figure 5) having a memory (see unit I from Figure 5);

a local database (see unit 5 from Figure 1) coupled to said processor and to store records containing telephone numbers, names, and other information (see Figure 2);

a search engine to run on said processor and to search said database for a record containing a telephone number of a second party (see unit 1 from Figure 1) to an ongoing telephone call;

a search initiator to run on said processor and to initiate a search for information associated with said second party on an external, remote database (see unit 6 from Figure 1) if the search engine does not find a record containing the telephone number; and

a display (see unit 4a from Figure 4) coupled to the processor to display information obtained from said local database, and if information is not found on said local database, to display information obtained from said remote database, the information obtained from either source to be displayed while said call is in progress (see Figures 3 and 4).

Regarding claim 54, see column 4.

***Claim Rejections - 35 USC § 103***

3. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

4. Claims 9-14, 39-43 and 50-52 are rejected under 35 U.S.C § 103(a) as being unpatentable over DeFazio in view of Romero, U.S. Patent No. 6,009,158 (hereinafter Romero).

Regarding claim 9, DeFazio discloses a system comprising:

a personal-use device (see unit 4a from Figure 1) that is standalone, portable, and separate from a telephone (see unit 4 from Figure 1) and another personal-use device (see unit 6 from Figure 1), the standalone device connectable to at least one of a telephone line or the other personal-use device (see Figure 1);

a processor (see unit F from Figure 5);

a storage (see unit I from Figure 5) coupled to said processor to store a first database (see unit 5 from Figure 1)

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with a plurality of records, each containing a telephone, a name and other information (see Figure 2); and

an application stored in said storage to enable said processor to access the telephone number of a second party to an ongoing telephone call, search said first database for a record containing said telephone number, and display a name, telephone number and other information associated with said record on the standalone, portable device, otherwise, if the record is not found in the first database, said application to enable said processor to automatically initiate a search for information relating to said telephone number on a second, remotely located database (see unit 6 from Figure 1), and to display information obtained from the second database on said standalone, portable device during the ongoing call (see Figures 3 and 4).

DeFazio fails to teach the standalone, portable device has the processor, storage an application. Nonetheless, Romero discloses this limitation (see Figure 4). As a result, it would have been obvious to one of ordinary skill in the art to modify DeFazio with the caller-ID device of Romero. This modification would have improved the convenience of DeFazio by placing Database 5 as close to the called subscriber as possible as suggested by DeFazio (see column 3).

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Regarding claim 10, see column 4 of DeFazio.

Regarding claim 11, see Figures 3 and 4 of DeFazio.

Regarding claim 12, see Figures 3 and 4 of DeFazio.

Regarding claim 13, see column 4 of DeFazio.

Regarding claim 14, see column 4 of DeFazio.

Regarding claim 39, see Figure 1 of DeFazio.

Regarding claim 40, DeFazio does not teach the standalone portable device is wirelessly connectable to the other personal-use device. However Romero teaches this feature (see column 8). For this reason, it would have been obvious to one of ordinary skill in the art to modify DeFazio with the communication link of Romero. This modification would have improved the flexibility of DeFazio by allowing the caller ID device to be deployed in various kinds of networks as suggested by Romero (see column 7).

Regarding claim 41, see Figure 1 of DeFazio.

Regarding claim 42, see Figure 1 of DeFazio.

Regarding claim 43, see Figures 3 and 4 of DeFazio.



As per claim 50, DeFazio teaches the personal-use device comprises a battery to power said device (see Figure 1). DeFazio does not explicitly teach enabling transport while said device is operational. However Romero teaches this feature (see column 8). For this reason, it would have been obvious to one of ordinary skill in the art to modify DeFazio with the communication link of Romero. This modification would have improved the flexibility of DeFazio by allowing the caller ID device to be deployed in various kinds of networks as suggested by Romero (see column 7).

Regarding claim 51, see Figure 4 of Romero.

Regarding claim 52, see Figure 4 of Romero.

5. Claims 29 and 30 are rejected under 35 U.S.C § 103(a) as being unpatentable over DeFazio in view of Suzuki, U.S. Patent Application Publication No. 2001/0027098 (hereinafter Suzuki).

On the issue of claim 29, DeFazio does not explicitly disclose enabling a user to define a search path for searching a plurality of remote sources for the information. Despite this shortcoming, Suzuki reveals this feature (see paragraph 0072). For this reason, it would have been obvious to one of ordinary skill in the art at the time the invention was made to modify

DeFazio with the hierarchy of Suzuki. This modification would have improved the convenience of DeFazio by allowing a search process to be specified in advance as suggested by Suzuki.

Regarding claim 30, see column 3 of DeFazio.

6. Claim 38 is rejected under 35 U.S.C § 103(a) as being unpatentable over DeFazio combined with Romero in further view of Sawaya, U.S. Patent No. 6,125,170 (hereinafter Sawaya).

Regarding claim 38, the combination of DeFazio and Romero makes absolutely no mention of a printer housed in the portable device. Yet, Sawaya discloses this handy feature (see Figure 1). Thus, it would have been apparent to an individual of plain ability in the field to further alter the combination of DeFazio and Romero with the printer invented by Sawaya. This adaptation would have enhanced the system's user friendliness by allowing visual indicia to be generated on a paper slip as suggested by Sawaya (see abstract).

7. Claim 53 is rejected under 35 U.S.C § 103(a) as being unpatentable over DeFazio combined with Bodnar et al, U.S. Patent No. 6,658,268 (hereinafter Bodnar).

As for claim 53, DeFazio does not show the claimed button. However Bodnar discloses this limitation (see column 10). Hence, it would have been obvious to one of ordinary skill in the art to modify DeFazio with the CDO of Bodnar. This modification would have improved the convenience of DeFazio by providing information in a convenient, transparent manner as suggested by Bodnar (see column 2).

#### ***Response to Arguments***

8. Applicant's arguments have been considered but are deemed to be moot in view of the new grounds of rejection.

#### ***Conclusion***

9. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Olisa Anwah whose telephone number is 571-272-7533. The examiner can normally be reached on Monday to Friday from 8.30 AM to 6 PM. If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Fan Tsang can be reached on 571-272-7547. The fax phone numbers for the organization where this application or proceeding is assigned are 571-273-8300 for regular communications and 571-273-8300 for After Final communications.

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Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is 571-272-2600.

O-A.

Olisa Anwah  
Patent Examiner  
April 3, 2006



FAN TSANG  
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